REMARKS

I. Status of the Claims

Claims 1-24 are pending in this application. Claims 8 and 9 have been withdrawn as being drawn to non-elected species of deposition entities, and claims 11-24 have been withdrawn from further consideration as being drawn to a non-elected invention.

Applicants amended claims 1 and 2 in this response. Specifically, Applicants amended claim 1 to incorporate a provision recited in originally-filed claim 2. Accordingly, Applicants submit that no new matter has been added by the foregoing amendments.

Applicants note that, at page 2 of the Office Action, the Examiner has indicated that claim 10 is pending but withdrawn from consideration; Applicants submit, however, that claim 10 should not be withdrawn from consideration. See Response dated September 18, 2007, page 3. Applicants respectfully request clarification of the record, and indication that claim 10 was considered by the Examiner in the next paper.

Based on the foregoing, Applicants believe that claims 1-7 and 10 are currently under consideration.

II. Rejections Under 35 U.S.C. § 102(b)

Claims 1, 5, and 7 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,855,753 ("Trau") and claim 4 stands rejected as being anticipated or in the alternative under 35 U.S.C. § 103(a) as being obvious over Trau for the various reasons discussed at page 3 of the Office Action. Applicants respectfully traverse these

rejections for at least the reasons that follow.

Rejection of Claims 1, 5, and 7

The Examiner rejected claims 1, 5, and 7 under 35 U.S.C. §102(b) as being anticipated by Trau '753. The Examiner states that "Trau's invention is directed to a method for electrophoretically depositing particles onto an electrode and electrohydrodynamically assembling the particles into crystalline structures." Office Action at 3. The Examiner alleges that "Trau discloses that the method comprises all the steps as claimed (Fig. 1 and col. 4, lines 20-42)." *Id.* This rejection is respectfully traversed.

Applicants respectfully submit that the foregoing amendment to claim 1 renders moot this rejection. Specifically, the amendment to claim 1 inserts the provision "a predetermined concentration in the range of about 10 μg/ml to about 1 mg/ml" from claim 2, which was not rejected by the Examiner, into independent claim 1. As acknowledged by the Examiner, Trau does not teach "the recited concentration of the deposition entity." Office Action at 4. Accordingly, Trau does not teach every element recited in independent claim 1 and hence Applicants respectfully request that the 102(b) rejection be withdrawn.

B. Rejection of Claim 4

The Examiner rejected claim 4 under 35 U.S.C. §102 (b) as being anticipated by or, in the alternative, under 35 U.S. C. 103(a) as being obvious over Trau. The Examiner alleges that "Trau discloses in paragraph 3 of col. 5 an electric field between 50-100 V. cm^{-1}" and further suggests that it has been held that the disclosure "in the

prior art of any value with the claimed range is an anticipation of that range." Office Action at 3.

As above, Applicants respectfully submit that the foregoing amendment to claim 1 renders moot this rejection. The Examiner acknowledged that Trau does not teach "the recited concentration of the deposition entity" (Office Action at 4), but such a concentration is now recited in claim 1. Accordingly, Trau does not teach every element recited in independent claim 1 and hence Applicants respectfully request that the 102(b) rejection be withdrawn.

II. Rejection Under 35 U.S.C. §103(a)

Claims 2, 3, and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Trau. As stated by the Examiner, "[t]he difference between Trau as applied above and the instant claims are the recited concentration of the deposition entity and solution's volume, the recited the distance between the electrodes and the thickness of the deposited layer. " Office Action at 4.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

(1) Determine the scope and content of the prior art;

(2) Ascertain the differences between the prior art and the claims in issue;

(3) Resolve the level of ordinary skill in the pertinent art; and

(4) Evaluate evidence of secondary considerations.

The obviousness or nonobviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1730, 82 U.S.P.Q.2d 1385, 1388 (2007).

Indeed, to establish a prima facie case of obviousness, the Examiner must consider the invention as "a whole without the benefit of hindsight, and the claims must be considered in their entirety." *Rockwell Int'l Corp. v. U.S.*, 147 F.3d 1358, 1364, 47 U.S.P.Q.2d 1027, 1031 (Fed. Cir. 1998). Moreover, the prior art reference relied upon in a rejection must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *See W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983); *see also Graham*, 383 U.S. at 17, 148 U.S.P.Q. at 467.

In addition, the Supreme Court mandates that "[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit." *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q.2d at 1396 (citing *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")).

In the present case, a review of Trau in its entirety, as required by *Graham*, indicates that there exists no teaching in this reference showing, for example, that the claimed concentration of the deposition entity is a result-effective variable. "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which

achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." M.P.E.P. §2144.05 I.B., citing *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

Here, the Examiner has not, and can not, point to any disclosure in Trau that shows, for example, that the claimed concentration of the deposition entity is a result-effective variable. No rationale underpinning has been set forth that supports the conclusion that the concentration of any deposition entity that may be disclosed in Trau should be modified. Moreover, the Examiner has presented nothing of record even alleging the concentration range originally recited in claim 2, and now recited in independent claim 1. Rather, the Examiner relies solely on the unsupported, conclusory statement that it would have been obvious to modify Trau's teachings - a reliance that is expressly prohibited by the holding in *KSR*.

Accordingly, Applicants respectfully submit that the rejection under under 35 U.S.C. §103(a) is in error, and request that it be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper or any other paper or matter in this application, including

extension of time fees, to Deposit Account No. 501946, and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Marc E. Brown, Registration No. 28,590

2049 Century Park East, 38th Floor
Los Angeles, CA 90067

Phone: (310) 277-4110
Facsimile: (310) 277-4730

Date: July 9, 2008

Please recognize our Customer No. 33401 as our correspondence address.